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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------|-------------|----------------------|-----------------------|------------------|
| 10/757,266 | 01/14/2004 | George Koutlakis | 030901 | 4897 |
| 26285 | 7590 | 10/12/2006 | EXAMINER | |
| KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP | | | MARCHESCHI, MICHAEL A | |
| 535 SMITHFIELD STREET | | | ART UNIT | |
| PITTSBURGH, PA 15222 | | | PAPER NUMBER | |

1755

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|-----------------------------------------------------------------------|------------------------------------------|-----------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/757,266 | Applicant(s) KOUTLAKIS ET AL. | |
| | Examiner Michael A. Marcheschi | Art Unit 1755 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 15-32.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
(See attached)
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 Michael A. Marcheschi
 Primary Examiner
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ATTACHMENT TO ADVISORY ACTION:

At the onset of the response, applicants state that the declaration filed 4/24/06 addresses the central argument of the obvious rejections and that the examiner has not fully considered this declaration. The examiner is fully aware of this declaration as has given it its proper weight, contrary to applicants position. As previously stated, the declaration implies that the references are directed only to blasting media. The examiner is aware of the teachings of the references that define blasting media, however, as defined previously, the references are not only limited to blasting media because Lane et al. (068) teaches an example of abrasive application in column 4, lines 9+ and prior to this passage (lines 7-8), the reference states that the particles can be used in abrasive applications (i.e. this does not limit the reference to blasting media, but rather implies any abrasive application). In addition, claim 1 of this reference only defines "grit" and also does not limit the claim to blasting media. **"A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments (i.e. example)"** See *In re Van Marter*, 144 USPQ 421. Although Koutlakis et al. only suggest blast media in the **examples** (reference is not limited to the examples), the claims of the reference do not limit the application, and as defined in the rejections, the use of this grit as a milling (agitating) media would have been appreciated by the skilled artisan. In addition, column 5, lines 50-51 of this reference states that the invention is based on abrasive grits and that the solid material can be ground to an appropriate size. The broad interpretation of this is that the solid material can be ground to an appropriate size depending on its application. Following this statement is the criteria that the abrasive grit is used as blasting media. This criteria can be considered a preferred embodiment and if the reference was only limited to blasting media, why doesn't

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claim 1 define a method for producing blasting media? To the contrary, the claim defines a method for producing abrasive grit and the interpretation of abrasive grit is much broader than a blasting media (i.e. abrasive media can encompass a tumbling media). In addition, when blasting media is defined in column 5, lines 53-54, the reference states that the abrasive grit is adapted to be used as a blasting media and this is **not** a positive limitation that the abrasive grit is a blasting media. "Adapted to be" does not limit the reference only to the defined application. The declaration also states that the blasting compositions of the primary references are unsuitable for agitating media because of clumping. This statement relies on the presumption that the references only teaching blasting media, however, as clearly defined above, the references are not limited to these applications. In addition, the declaration does not address the combination as applied. In summary, the declaration only defines that the polysaccharide grits of the references are blasting media, however, the references clearly do not limit the grits to only blasting media. This is clearly defined above and that fact the references only claim a process for producing grit particles with no limitation placed on the size or application (see independent claim 1 in both patents). In view of this, the independent claims are not only directed to blasting particles and it appears that applicants are reading limitations into independent claim 1 of both references. The lack of any size limitation in claim 1 of the parents makes any size obvious and the examiner has clearly established reasons why the claimed size is obvious.

Applicants also state that the examiner acknowledges that both primary references disclose only polysaccharide **blasting media**. The examiner has not made this acknowledgement but has previously defined that the references teach abrasive grits and the

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broad generic interpretation of “abrasive grits” does **not** limit the references to only blasting media.

Applicants argue that there is not motivation to combine the references. The examiner disagrees because Lane et al. (068) teaches that the particles can be used in abrasive applications (i.e. this does not limit the reference to blasting media but rather implies any abrasive application). This statement, alone, provides the necessary motivation for the combination. With respect to Koutlakis et al., column 5, lines 50-51 of this reference, states that the invention is based on abrasive grits and that the solid material can be ground to an appropriate size. The broad interpretation of this is that the solid material can be ground to an appropriate size depending on its application. This statement, alone, provides the necessary motivation to use the abrasive grit of the reference in any abrasive application. In addition, the independent claim in both references defines abrasive grit particles, in the broadest sense, and this also, provides the necessary motivation to use the abrasive grit of the references in any abrasive application.

Applicants also state that it is improper to combine the references if the proposed modification would render the prior art being modified unsatisfactory for its intended use. The examiner is aware of this, however, applicants appear to be focusing on the references intended use being only limited to blasting media. As clearly defined above, the references are **not** only limited to blasting media, but rather abrasive grit, in general, (i.e. see the independent claims of the reference, as well as, the other teachings above). In view of this, the examiner is unclear as to how the modification proposed by the examiner renders the prior art unsatisfactory for abrasive applications.? Why are the references only limited to blasting media? Applicants provide no clear evidence to support the arguments based on the limiting argument (limited to

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only blasting media). The references never define or imply that they are only limited to blasting media but rather imply that this is a possible use. One skilled in the art would have appreciated from the references, as a whole, that they can be use in any abrasive applications.